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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/156,886	09/18/1998	BERNHARD MUSSIG	101769-26/tesa 516.1	1668

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EXAMINER
GOFF II, JOHN L

ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HG

Office Action Summary	Application No.	Applicant(s)	
	09/156,886	MUSSIG, BERNHARD	
	Examiner	Art Unit	
	John L. Goff	1733	

-- The MAILING DATE of this communication app ars on th cover sh et with the correspond nce addr ss --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *37-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *37-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is in response to the request for continued examination filed on 1/16/03. It is noted Amendment E has been entered. All previous objections to the specification have been overcome. The terminal disclaimer filed 11/29/02 overcomes the double patenting rejection over U.S. Patent 6,319,353. The 35 U.S.C. 103 rejections over Wendler et al. or Matsui et al. each in view of either Davis or Lipman are withdrawn in favor of Koga et al. (EP 661364) in view of Dobashi et al. (U.S. Patent 5,643,676) as Koga et al. are directed to a protective film for attachment to a metal surface comprising the claimed adhesive composition.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/29/02 (Amendment E) has been entered.

Claim Rejections - 35 USC § 103

4. Claims 37-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koga et al. (EP 661364) in view of Dobashi et al. (U.S. Patent 5,643,676).

Koga et al. are directed to a self-adhesive protective film for protecting the surface of a substrate (e.g. a metal substrate) from corrosion, dust deposition, or damage during transport or storage. Koga et al. teach the film comprises a backing film and an adhesive layer. Koga et al. teach the protective film is produced by co-extruding the backing film and adhesive layer. Koga et al. teach the backing film comprises a multilayer structure wherein the base layer of the film is formed of α-olefins and the layer contacting the adhesive layer is formed of α-olefins such as propylene to form a strong bond with the adhesive layer, i.e. it acts as an adhesion promoting layer. Koga et al. teach the adhesive layer comprises a plurality of α-olefinic copolymers having 2 to 12 carbon atoms and further comonomers including dienes (the dienes comprise 0-50% by weight of the adhesive layer). Koga et al. teach the α-olefinic copolymer content is preferably 15-70 mol% of any single α-olefin. Koga et al. teach the adhesive layer further comprises standard additives. Koga et al. further teach the protective film has a bond strength to steel of at least 20g/25mm (Page 2, lines 12-16 and 20-56 and Page 3, lines 30-36, 41-42, 45-50, 54-55 and Page 4, lines 19-21, 23-25, 30-34, and 43-46 and Page 5, lines 23-24, 33-34, 44-49, 56-58 and Page 6, lines 1, 6-7, and 18-21).

Regarding claims 37, 38, and 39, Koga et al. are silent as to using the protective film for protecting the paint finish of a vehicle. However, one of ordinary skill in the art at the time the invention was made would have readily appreciated using the protective film taught by Koga et al. to protect the paint finish of a vehicle as it was well known in the art to use protective films

such as those taught by Koga et al. to protect the paint finish of a vehicle from corrosion, dust deposition, or damage during transport or storage as shown for example by Dobashi et al.

Dobashi et al. are directed to a self-adhesive protective film which is used to temporarily protect automotive coatings during transportation and storage of automobiles. Dobashi et al. teach the protective film comprises a backing film and an adhesive layer. Dobashi et al. teach the backing film includes light stabilizers (such as HALS in an amount of 0.1 to 5% by weight) to give the protective film a UV permeability in the range from 190 to 370 nm of less than 1%, i.e. the light stabilizers improve the weatherability of the protective film (Column 1, lines 5-8 and Column 2, lines 19-25 and 59-65 and Column 3, lines 27-33 and Column 4, lines 1-10 and Column 5, lines 57-59 and Column 7, lines 5-12).

Regarding claims 37 and 42, Koga et al. are silent as to the specific Mooney viscosity of the adhesive layer. However, the adhesive composition taught by Koga et al. is the same as that claimed, and one of ordinary skill in the art would readily expect both compositions to have the same Mooney viscosity.

Regarding claims 41, 45, 46, and 50, Koga et al. are silent as to the backing film including light stabilizers. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the backing film taught by Koga et al. light stabilizers as it was well known in the art to include light stabilizers in the backing film to improve its weatherability as shown for example by Dobashi et al.

Response to Arguments

5. Applicant's arguments with respect to claims 37-55 have been considered but are moot in view of the new ground(s) of rejection. It is noted Koga et al. do not specifically limit the adhesive composition from containing 75 mol% or more of any single α-olefin. However, Koga et al. do teach the α-olefinic copolymer content is preferably 15-70 mol% of any single α-olefin. Furthermore, applicant has not shown that limiting any single α-olefin to 75 mol% or less results in any unexpected results. The table submitted in paper #16 (the summation of data in the specification) does not show unexpected results as the inventive examples 1-4 differ from the comparison examples 1-3 and 5 in that while the inventive examples do not contain 75 mol% or more of any single α-olefin the inventive examples also contain a diene component that is not present in the comparative examples. It is unclear as to whether the unexpected results obtained by the inventive examples are due to limiting the adhesive composition from containing 75 mol% or more of any single α-olefin or to including a diene component. This is further evidenced by comparative example 4 wherein the adhesive composition does not contain 75 mol% or more of any single α-olefin and the adhesive composition does not contain a diene component yet the protective film creates defects in the paint.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Goff whose telephone number is 703-305-7481. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

John L. Goff
May 12, 2003

JEFFREY H. AFTERGUT
PRIMARY EXAMINER
GROUP 1300